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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,504	06/09/2006	Keiichi Asami	000023-086	2337

7590 11/24/2009
Buchanan Ingersoll
Burns Doane Swecker & Mathis
P O Box 1404
Alexandria, VA 22313-1404

EXAMINER

CHOI, LING SIU

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,504	Applicant(s) ASAMI ET AL.	
	Examiner Ling-Siu Choi	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 16-28 and 34-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/26/2008, 08/30/2006, and 11/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Response to Election/Restriction filed 07/10/2009. Claims 1-42 are now pending. Claims 1-15 and 29-33 of Group I have been elected without traverse.

Claim Objections

2. Claims 8-10 are objected to because of the following informalities: Claims 8-10, line 2, "the thermoplastic elastomer" is suggested to be changed to --the thermoplastic elastomer (A)--.

Appropriate correction is required.

Claim Analysis

3. Summary of Claim 1:

A solvent dispersion of a composite resin, which comprises		
	a solvent and	
	a composite resin comprising	
		a thermoplastic elastomer (A) and
		a polymer of copolymerizable monomers (B) comprising a monomer having an α,β -monoethylenically unsaturated group and other copolymerizable monomer(s),
wherein the thermoplastic elastomer (A) is a propylene-based elastomer having		

$M_w/M_n \leq 3$ (GPC), and
the copolymerizable monomers (B) include at least one monomer containing no functional groups.

Summary of Claim 7:

The solvent dispersion of a composite resin according to claim 1	
wherein the thermoplastic elastomer (A) has	
	an intrinsic viscosity $[\eta]$ of 0.1 to 12 dl/g as measured at 135°C in decalin, and is
	a propylene-based elastomer (I) which contains (a) 50 to 93 mol% of a unit derived from propylene , (b) 5 to 50 mol% of a unit derived from α-olefin , and (c) 2 to 40 mol% of a unit derived from ethylene , or
	a propylene-based elastomer (II) which contains (a) 50 to 95 mol% of a unit derived from propylene and (b) 5 to 50 mol% of a unit derived from α-olefin .

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-15 and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosch et al. (US 6,191,210 B1).

The present claims are drawn to product-by-process claims. The caselaw has held that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”

In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Rosch et al. disclose an aqueous coating material, comprising at least one water dilutable binder resulting from the **free-radical polymerization of (A) from 20 to 90 wt%** of a **mixture of monomers** comprising (a1) from 3 to 50% by weight of a first monomer selected from the group consisting of acrylic acid, methacrylic acid and mixtures thereof, and (a2) from 50 to 97% by weight of an ethylenically unsaturated second monomer which is different from said first monomer (a1) or a mixture of such ethylenically unsaturated monomers **in the presence of (B) from 9.9 to 79.9 wt% of a halogen-free copolymer** composed of (b1) from 1 to 99 wt% of propylene; (b2) from 1 to 99 wt% of at least one olefin which is copolymerizable with (b1) and which contains per molecule from five to twenty carbon atoms, with the exception of isoprene, and (b3) from 0 to 50 wt% of a member of the group consisting of ethylene, butylene, and mixtures thereof, and **(C) from 0.1 to 10 wt% of a free-radical initiator** or a mixture of free-radical initiators, and, after neutralization of at least 20% of the carboxyl groups which are present in the resulting polymerization product, **dispersing the polymerization product in water**, wherein the sum of the percentages by weight of components (A), (B), and (C) and of (a1) and (a2) and (b1), (b2) and (b3) is, in each case, 100

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wt%, wherein the mixture of monomers (a1) and (a2) is selected such that polymerization of the mixture of monomers (a1) and (a2) alone gives a polymer which has a glass transition temperature of from 0 to 150°C (claim 1). It is also noted that the molecular weight distribution for the high-conversion free radical polymerization is in the range of 2-5. Thus, the present claims are anticipated by the disclosure of Rosch et al.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Ling-Siu Choi/

Primary Examiner, Art Unit 1796

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November 10, 2009